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In re Application of
Woolston
Application No. 09/670,562
Filed: September 27, 2000
Attorney Dck't. No. 13466-002005

OFFICE OF PETITIONS

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: **DECISION ON PETITION**
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This is a decision on the petition filed June 22, 2005, which is being treated as a petition under 37 CFR 1.59 requesting that the communication filed by a third party on April 22, 2005, be expunged from the record.

The petition under 37 CFR 1.59 is **dismissed**.

BACKGROUND

Inspection of the above-identified non provisional application reveals that it was filed before November 29, 2000, and, as such, was not subject to a pre-grant publication. That inspection further reveals that a Notice of Allowance has not been mailed.

On April 22, 2005, a communication filed on behalf of a third party (eBay) was received. The communication specifically identified on the top page in a conspicuous location, the instant application number in the manner required by 37 CFR 1.5(a). While self-styled as a petition under 37 CFR 1.182, the communication requested that the USPTO take notice of its prior findings alleged to have been arrived at during the course of prosecution of 18 related (common inventorship) patent applications, and that the USPTO apply these findings consistently in the examination of the instant non provisional application. These findings are discussed in conjunction with, *inter alia*, at least 2 specifically mentioned U.S. Patents, several prior art articles, and assertions as to what the USPTO has held to be well known in the art during the examination of prior applications to the instant inventor.

OPINION

The instant petition notes that eBay is an adjudicated willful infringer of several MercExchange (the real party of interest herein) patents and contends that the eBay communication, characterized as 53 pages of "adversarial argument", is an "improper attempt" to participate in the *ex parte* prosecution of the instant non provisional application, requests that the USPTO deny eBay's request that the Office "take notice" of eBay's arguments, and further, requests that the Office expunge the eBay communication.

37 CFR 1.59 provides for the applicant's request for expungement of information in a patent application, other than the original papers upon which the filing date was granted. However, under the terms of the rule, petitioner "must ...establish to the satisfaction of the Director that the expungement of the information is appropriate..." See 37 CFR 1.59(b). Under the circumstances of this case, petitioner has not met his burden of proof.

Expungement of an Office communication would only be justified where that Office communication contained inappropriate statements that were not suitable for retention in the administrative record. Cf. 37 CFR 1.3, which requires that applicants must conduct their business with the USPTO with decorum and courtesy. While petitioner may disagree with the contents of the contested eBay communication, the USPTO has long held that a mere difference in opinion does not warrant expungement of part or all of a contested communication

from the file record. See e.g., Ex Parte Fox, 1910 Dec. Commissioner Pat. 123 (Comm'r Pat. 1910). The MPEP makes clear that the expungement of record information should occur in very limited situations. See MPEP § 724.05. That particular section of the MPEP and referenced-sections (e.g., MPEP § 724.02) address the following types of information as subject (or susceptible) to possible expungement:

- 1) trade secret information;
- 2) proprietary information;
- 3) protective order material;
- 4) unintentionally-submitted information; and
- 5) information submitted in a wrong application.

The above situations are the only known types of circumstances which have led to USPTO-information expungement. Clearly none of them applies here. Petitioner has not alleged that the information includes any trade secret, is proprietary in nature or is subject to a protective order. Neither was the information wrongly-submitted. Accordingly, no recognized basis for expunging information applies to this case and the USPTO sees no reason to exercise its discretion to deviate from, or expand upon, the above-established bases. See, e.g., Saxbe v. Bustos, 419 U.S. 65, 74 (1974) (acknowledging an agency's right to maintain a "longstanding administrative construction").

Indeed, while the petition contends (at 7, n.3) that the specific, limited provisions of 37 CFR 1.291 do not apply in this instance, inspection of the record does not reveal, and petitioner fails to advance, any persuasive showing that even assuming for the sake of argument the eBay communication is a noncompliant protest within the meaning of 37 CFR 1.291, § 1.291 or indeed, any other regulation, compels the expungement of the eBay communication under 37 CFR 1.59 without the opportunity for USPTO consideration of the information therein

Petitioner appears to overlook the fact that the eBay communication, notwithstanding its self-styling as a "petition", clearly constitutes a protest to the issuance of a patent to the above-identified application. That is, the communication specifically *identifies*, inter alia, prior patents, other publications, and other information, which the submitter requests be considered by the USPTO during the prosecution of the instant application.

37 CFR 1.291(a) provides in pertinent part that "a protest will be matched with the application file if it adequately identifies the patent application." As the eBay communication conspicuously and clearly identifies the instant application, it was readily matched with this application. 37 CFR 1.291(b) further states that a protest will be entered into the file if: (1) as here, the protest indicates service on the applicant as required by 37 CFR 1.248, (2) as here, the protest was filed prior to the earlier of the date the application was published or a notice of allowance under 37 CFR 1.311 was mailed, and (3) the protest complies with paragraph (c) of that regulation. Thus, the eBay protest facially meets the service and timeliness requirements of 37 CFR 1.291(b). If the eBay protest further meets the requirements of 37 CFR 1.291(c), then the rule accords an entry right to the eBay communication and further, states that the eBay protest will be considered by the examiner.

However, the rule does not likewise require the converse, that is: entry must be denied, and that the examiner will not consider the eBay protest, if either or both of sections (b) and (c) are not complied with by a given protest. See 37 CFR 1.291(g). Rather, even where a protest is entirely noncompliant (and it is not herein so decided), the treatment accorded that protest is discretionary with the USPTO per 69 *Fed. Reg.* 56482 at 56527 (Sept. 21, 2004):

Where a protest is entirely noncompliant with §§ 1.291(b), or (c), the prior art will not be made of record and the protest may be returned, or discarded, at the Office's option. Alternatively, the examiner may choose to consider any or all of the prior art submitted, in which case the examiner may choose to make certain of the prior art considered of record by citing it as an examiner's citation of prior art. The examiner need not make any prior art actually considered from a noncompliant § 1.291 protest of record.

The examiner may always look at, or consider any documents submitted in an application, under amended § 1.291. This is the same as in the past... Once a protest has been matched with an application the examiner is always free to look at, or consider, any document(s) or other information submitted in that protest whether or not the protest complies with 37 CFR 1.291 (emphasis added).

Accordingly, it is not here necessary to consider, on petition, whether the eBay protest is fully or partially compliant, or entirely noncompliant, as to whether that communication should now be properly expunged *vel non*. Rather, what initiates the discretionary USPTO treatment of even a noncompliant protest is the matching of the protest with the intended file.¹

Thus, as to whether the matched eBay protest is fully or partially compliant, and as to whether that protest, fully compliant or otherwise, will be considered and, if so, to what extent, is a matter(s) decided by the examiner. As such, the examiner's discretionary freedom in this matter should not be permitted to be curtailed—much less pre-empted—by way of a petition to expunge. Rather, 37 CFR 1.291 specifically provides for the consideration *vel non* and entry *vel non* of the eBay communication, and further, indicates that the issue of retention of the protest in the file is independent from the issue of consideration of the information provided in and by the protest. This conclusion is reinforced by consideration of the continuation of the above-quoted paragraph, *id.*:

Section 1.291 exists as a matter of administrative convenience for the Office; thus, a third party's failure to comply with any of the requirements of § 1.291 does not vest the applicant with any "right" to preclude consideration by the examiner of the information set forth/presented in a non-compliant protest. The noncompliant protest, however, will not be made of record and may be returned, or discarded (§ 1.291(g)) after consideration of the information contained therein, should the examiner desire to do so.

Thus even assuming for the sake of argument that the least favorable condition is present herein—that the protest is fully noncompliant, petitioner still does not have a vested right, in the first instance, to seek to preclude by way of a petition under 37 CFR 1.59, the examiner's possible consideration of the information contained in the eBay protest.

The further assertion that the eBay communication is an improper attempt to participate in the *ex parte* prosecution of the above-identified application, is simply not well taken. *See* 37 CFR 1.291(d). That is, the regulation has long expressly limited protestor participation to the filing of the protest and such involvement ends with the filing of the protest. *See* 47 Fed. Reg. 21746, 21749-50 (May 19, 1982); *see also* *In re Blaese*, 19 USPQ2d 1232, 1235 (Comm'r Pat. 1991)

DECISION

For the reasons given above, the petition under 37 CFR 1.59 to expunge the eBay protest of April 22, 2005, is **dismissed**. Rather, the Office treatment of the eBay communication is more properly governed by the provisions of 37 CFR 1.291.

The balance owed of the \$200 petition fee has been charged to counsel's deposit account.

The above-identified application is being referred to the Technology Center.

The examiner is advised that he is to determine whether the eBay communication complies with 37 CFR §§ 1.291(b) and (c) or not, and that he may take such action under 37 CFR 1.291 regarding that communication consistent with his determination, as he chooses.

Telephone inquiries relative to this decision should be directed to the undersigned at (571) 272-3217.



Brian Hearn
Petitions Examiner
Office of Petitions

¹ Since the instant non-provisional application was not published, the more stringent conditions of 37 CFR 1.99 and 1.291 pertaining to the content of protests in an already published application do not apply. Likewise, as the instant application is not a reexamination proceeding, the prohibitions of 37 CFR 1.535 are also immaterial here.